



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,710	03/23/2004	Teng-Kuei Yang	14311 B	5637

36672 7590 03/31/2006

CHARLES E. BAXLEY, ESQ.  
90 JOHN STREET  
THIRD FLOOR  
NEW YORK, NY 10038

EXAMINER

SHAMEEM, GOLAM M

ART UNIT PAPER NUMBER

1626

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/807,710

Applicant(s)

YANG ET AL

Examiner

Golam M. M. Shameem, Ph.D.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 9-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-3 and 9-17 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Claims 1-3 and 9-17 are currently pending in the instant application.

#### *Election/Restrictions*

The Markush group set forth in the claims includes both independent and distinct inventions, and patentable distinct compounds (or species) within each invention. However, this application discloses and claims a plurality of patentable distinct inventions far too numerous to list individually. Moreover, each of these inventions contains a plurality of patentable distinct methods, also far too numerous to list individually. ***For these reasons provided below, restriction to one of the following Groups is required under 35 U.S.C. 121***, wherein a Group is a set of patentable distinct inventions of a broad statutory category (e.g. compounds, methods of use, methods of making, etc.):

- I. Claims 1-3 and 9-17 drawn to a compound of the formula I [wherein R<sup>3</sup>, R<sup>4</sup>, and N form pyrrolidinyl] classified in class 548 and several subclasses.
- II. Claims 1-3 and 9-17 drawn to a compound of the formula I [wherein R<sup>3</sup>, R<sup>4</sup>, and N form morpholinyl] classified in class 544 and several subclasses.
- III. Claims 1-3 and 9-17 drawn to a compound of the formula I [wherein R<sup>3</sup>, R<sup>4</sup>, and N form piperidyl] classified in class 546 and several subclasses.
- IV. Claims 1-3 and 9-17 drawn to a compound of the formula I [wherein R<sup>3</sup>, R<sup>4</sup>, and N form three-to-eight-membered heterocycle] classified in classes 540, 544, 546, 548 and numerous subclasses.
- V. Claims 1-3 and 9-17 drawn to a compound of the formula I [wherein R<sup>1</sup> to R<sup>5</sup> are non-heterocycle] classified in class 564 and several subclasses.

The timely submission under 37 CFR 1.129(a) filed on 02/10/2006 is not fully responsive to the prior Office action mailed on 12/09/2005 because Applicant has failed to elect an Invention group (including an election of species). Since the submission appears to be a *bona fide* attempt to provide a complete reply to the prior Office action, Applicant is given a shortened statutory period of ONE MONTH or THIRTY DAYS from the mailing date of this notice, whichever is longer, to submit a complete reply in order to avoid abandonment. This time period may be extended pursuant to 37 CFR 1.136(a).

Restriction is required under 35 U.S.C. 121 to one of the above identified patentably distinct groups. A reply to this requirement must include an election of a single group for prosecution on the merits, even if this requirement is traversed, 37 CFR 1.143. Any reply that does not include election of a single group will be held nonresponsive. **Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits** to which the claims shall be restricted if no generic claim is finally held to be allowable that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

***Remarks***

Current status of claims 11-17 has not been identified in "This listing of claims" [Response, page 2] filed on 02/10/2006. It is requested to identify the current status of the claims 11-17 (canceled or pending) in the next communication.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is 571-272-0706. The Examiner can normally be reached on 7:30 am to 6:00 pm Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 571-273-8300 for after final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR only. For more information about the pair system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Golam M M Shameem, Ph.D.  
Primary Examiner  
Art Unit 1626  
Technology Center 1600



**GOLAM M. M. SHAMEEM, PH.D.  
PRIMARY EXAMINER**

February 28, 2006